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In re Application of :
James G. Keck :
Serial No.: 09/601,997 : PETITION DECISION
Filed: December 15, 2000 :
Attorney Docket No.: 24743-2307US :

This is in response to the petition under 37 CFR 1.181, filed October 30, 2006, requesting withdrawal of the Finality of the last Office action.

BACKGROUND

A review of the file history shows that this application was filed on December 15, 2000, and is the National Stage of International Application No. PCT/US98/27942, filed December 18, 1998.

On September 26, 2002, the examiner mailed to applicants a restriction requirement setting forth five groups into which claims 1-57 were divided under 35 U.S.C. 121 and 372.

On October 25, 2002, applicant filed a response to the restriction requirement wherein Group II (claims 8-14) was elected without traverse. Claim 8 was amended. Claims 1-7 and 15-57 were canceled, and claims 58-69 were added.

The examiner mailed a new Office action to applicant on January 9, 2003, acting on claims 8-14. Claims 58-69 were withdrawn from consideration as being directed to a non-elected invention since claims 58-69 all depended from canceled claim 1, drawn to a non-elected invention. Claim 8 was objected to. Claims 8-14 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 8-14 were rejected under 35 U.S.C. 102(e) as being anticipated by Beach et al.

Applicant replied on May 7, 2003, by filing an amendment amending claims 8, 14, 58, 62 and 64-69 and adding claims 70-72. Applicant responded to each of the rejections/objections of record appropriately.

On July 25, 2003, the examiner mailed a Final Office action to applicant. Claims 58-69 were rejoined with the elected invention. The rejection of claims 8-14 under 35 U.S.C. 102(e) as being anticipated by Beach et al. was maintained, and claims 58-72 were rejected under 35 U.S.C. 102(e) as being anticipated by Beach et al for the reasons of record as set forth in the

Office action mailed January 9, 2003. The examiner concluded that applicant's amendment necessitated the new ground(s) of rejection and made the action FINAL. The objection to claim 8 and the rejection of claims 8-14 under 35 U.S.C. 112, second paragraph, were not further addressed by the examiner.

Applicant filed a Request for Continued Examination (RCE) on January 26, 2004. Claims 8 and 58-59 were amended. Applicant responded to the rejection of claims 8-14 and 58-72 under 35 U.S.C. 102(e) appropriately.

On April 20, 2004, the examiner mailed to applicant a Non-Final Office action. Applicant's arguments with respect to claims 8-14 and 58-72 were found to be moot in view of the new grounds of rejection. Claims 8-14 and 58-72 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Applicant replied on October 25, 2004, by amending claim 8 and responding to the rejection under 35 U.S.C. 112, second paragraph, of record appropriately.

On February 3, 2005, the examiner mailed to applicant a Non-Final Office action. Applicant's arguments with respect to claims 8-14 and 58-72 were found to be moot in view of the new grounds of rejection. Claims 8-14 and 58-72 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 8-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. in view of Gudkov et al.

Applicant replied on August 3, 2005, by amending claims 8, 14 and 58; adding claims 73-74; and responding to the rejections of record appropriately.

On October 20, 2005, the examiner mailed to applicant a Final Office action. Applicant's arguments with respect to claims 8-14 and 58-72 were found to be moot in view of the new grounds of rejection. Claims 8-14 and 58-74 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The rejection of claims 8-14 under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. in view of Gudkov et al. was maintained.

On April 20, 2006, applicant filed an Amendment After Final wherein claims 8 and 58 were amended, and claim 74 was canceled. Applicant responded to all of the rejections of record. Applicant also filed a Notice of Appeal.

The examiner mailed to applicant an Advisory Action on May 22, 2006. Applicant's Amendment After Final filed April 20, 2006 was entered and an explanation of how the new or amended claims would be rejected was provided. The rejections of claims 8-14 and 58-73 were maintained for the reasons of record.

On September 20, 2006, applicant filed a second Amendment After Final wherein claim 8 was canceled, and claims 9-14, 58, 65-69 and 73 were amended. Applicant asserted, pursuant to an interview on September 12, 2006, that the examiner agreed to consider the second Amendment After Final that incorporated the suggestions provided by the Examiner during the interview and

in view an e-mail communication on September 14, 2006. Applicant responded to each of the rejections of record appropriately.

On October 18, 2006, the examiner mailed to applicant a second Final Office action wherein the finality of the previous Office action was withdrawn. Applicant's arguments with respect to newly amended claims 9-14 were found moot in view of a new ground(s) of rejection. Claims 9-14 (newly rejected) and 58-73 (previously rejected) were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The examiner asserted that due to the ambiguity associated with claim 58, and those claims dependent therefrom, the prior art would not be applied until these issues were addressed.

This petition was filed October 30, 2006, to withdraw the finality of the Office Action mailed on October 18, 2006.

DISCUSSION

Applicant argues that the Office action mailed on October 18, 2006, which was made FINAL, introduces new grounds of rejection of claims 58-63 and 70 under 35 U.S.C. 112, second paragraph, that were not necessitated by amendment. Claim 58 is independent, and claims 59-63 and 70 all ultimately depend from claim 58.

In the Office action mailed on October 18, 2006, claims 9-14 and 58-73 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The examiner asserted:

"Instant claim 58 (and those claims dependent therefrom) remains vague and indefinite to the extent that the instant claim still recites wherein the 'antisense strand that, when expressed as RNA, binds to an mRNA transcribed from the target nucleic acid sequence,' (see lines 15-16), this statement suggest that the antisense RNA produced from the sense stranded of the cloned double stranded DNA, targets an mRNA other than the mRNA product 'coded for by a sample nucleic acid in the target nucleic acid' as set forth in the preamble of the claimed method."

The examiner further cited that the nature of the term "oligonucleotide family" recited in line 7 was vague and indefinite. The examiner also noted the claim 58 was incomplete since there was no mention of a control, untransfected host cell.

Applicant asserts that the examiner set forth a new ground of rejection and that the rejection could have been made in a prior Office action. Applicant contends that claim 58, as pending at the time of previous Office action mailed October 20, 2005, recited the phrase "antisense strand that, when expressed as RNA, binds to an mRNA sequence transcribed from the target nucleic acid sequence".

Contrary to applicant's assertions, no new ground of rejection is set forth in the Office action mailed on October 18, 2006; the examiner has merely expanded on the rationale for finding said claims indefinite. In the Office action mailed on October 20, 2005, the examiner noted:

“The metes and bounds of the claimed method are vague and indefinite because the nature of the transcription product is vague and indefinite, the claim recites that the transcription product possess a sequence that is complementary to a sequence contained in the mRNA transcribed from the target nucleic acid molecule, the claim then further recites that the coding sequence for the transcription product encodes an antisense nucleic acid that binds to the mRNA transcribed from the target nucleic acid molecule. It is the examiner's understanding that the transcription product that comprises a sequence that is complementary to the mRNA transcribed from the target nucleic acid molecule, is already "antisense" to the mRNA transcribed from the target nucleic acid molecule by means of its complementary sequence. It is unclear if the claim encompass an additional antisense molecule (see lines 15-18) beyond that of the transcription product described in lines 11-14 of this claim.”

The examiner clearly identifies the text of lines 11-18 (claim 58), which encompasses the phrase “antisense strand that, when expressed as RNA, binds to an mRNA transcribed from the target nucleic acid sequence”, as being the basis for finding the claim(s) indefinite.

Claim 58 was amended by applicant on April 20, 2006, and September 20, 2006, prior to mailing the Final Office action on October 18, 2006. The rejection of claim 58 (and claims dependent therefrom) under 35 U.S.C. 112, second paragraph, was maintained in the Advisory Action mailed on May 22, 2006, and in the Final Office action mailed on October 18, 2006. It is noted that the finality of the last Office action was necessitated by amendment; however, the new rejection of claims 9-14 under 35 U.S.C. 112, second paragraph, was necessitated because claims 9-14 were amended to depend from rejected claim 58.

The examiner has not set forth a new ground of rejection in regards to claims 58-63 and 70 under 35 U.S.C. 112, second paragraph, in the Office Action mailed October 18, 2006. but the Office action appears to be incomplete. In the Office action mailed October 20, 2005, the examiner rejected claims 8-14 under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. in view of Gudkov et al. The rejection of claims 8-14 under 35 U.S.C. 103(a) was maintained in the Advisory Action mailed May 22, 2006. However, the examiner declined to apply a prior art rejection in the Office action mailed October 18, 2006, until the ambiguities in the claims were resolved.

In view of this statement the previous Office Action, mailed October 18, 2006, is withdrawn as incomplete and applicant need make no response thereto.

DECISION

The petition is **GRANTED-IN-PART** in that the Office action is withdrawn.

The application will be returned to the examiner for preparation of a new Office action not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

A handwritten signature in cursive script, reading "George C. Elliott". The signature is written in dark ink and is positioned above the printed name and title.

George Elliott
Director, Technology Center 1600
pl/wrd